

REMARKS

General Comments:

In connection with the objection to the drawings, Applicant has cancelled the subject matter from the claims in an effort to facilitate prosecution. However, Applicant does not agree that the subject matter is not supported by the Application. Applicant submits the subject matter is indeed supported by the application. Applicant reserves his right to prosecute the cancelled subject matter in another continuation-type application.

Rejections Under 35 U.S.C. §112:

According to the Office Action, claims 6, 9, 12, 17, 21, and 24 are rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement.

Claims 6, 9, 12, and 24 have been cancelled as indicated above. Consequently, the rejection associated with these claims is moot.

Regarding claims 17 and 21, the Office Action states that the disclosure does not specify how to measure a void. Applicant respectfully disagrees.

There should be no doubt that an image captured using a fiber optic may be measured. A wide range of techniques may be used to measure features and landmarks of an image on a monitor. For example, images may be presented on the monitor and observed as stated in the Application at, for paragraph nos. 47, 71, and 77. Measurements may be taken using a hand-held ruler, and measuring the images on the monitor. A scaling factor may be required to scale the data. Other more sophisticated techniques may be used to back out measurements of anatomical features on a monitor. Software may be used to this end. Regardless of the specific technique used to measure a void as shown in an image, Applicant submits the patent application along with the claims would enable a person skilled in the relevant art to make and use the invention without undue experimentation.

Based on the foregoing, Applicant submits the claimed invention complies with Section 112 and respectfully requests withdrawal of the rejections of claims 17 and 21. Applicant also notes that an affidavit may be provided as further evidence should the examiner continue to assert that the claims are not in compliance with Section 112.

Rejections Under 35 U.S.C. §102:

According to the Office Action, claims 1-2, 4-6, 10-18, and 25-26 are rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Pat. No. 6,277,112 to Underwood et al. (hereafter "Underwood").

Applicant respectfully disagrees. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." MPEP § 2131 *citing* *Verdegaal Bros. V. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987).

As indicated above, Claim 1 recites two steps that are not found in Underwood. 1) a fiber optic is inserted through an access device into the nucleus of a disc: 2) viewing the interior of the disc with the fiber optic. Emphasis supplied.

The Office Action does not indicate where in Underwood it is disclosed to insert a fiber optic into the nucleus of a disc or to view the nucleus of the disc. In contrast, Underwood describes, amongst other things, inserting the electrode array working end of an electrosurgical probe within the disc, and not a fiber optic. Applicant does not dispute that Figs. 15-18 show the treatment of a herniated disc and the insertion of an electrode array into the disc. But, Applicant does not agree that these disclose a fiber optic being positioned within the nucleus as claim 1 recites.

Based on the foregoing, reconsideration and withdrawal of the rejection is requested. Because the other claims depend from claim 1 or a claim depending thereon, Applicant submits all claims are not anticipated by the Underwood.

Rejections Under 35 U.S.C. §103:

According to the Office Action, claims 3, 7-8, and 21 are rejected under 35 U.S.C. § 103 as being unpatentable over Underwood. Applicant respectfully disagrees.

An Office Action must establish a *prima facie* case of obviousness in order to reject claims under 35 U.S.C. § 103. To establish a *prima facie* case of obviousness, at least three basic criteria must be met: 1) there must be some suggestion or motivation, either in the reference itself or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings; 2) there must be a reasonable expectation of success; and 3) the prior art reference (or references when combined) must teach or suggest all the claim limitations. MPEP § 706.02(j).

In this instance, as discussed above in connection with the Section 102 rejection, Underwood does not teach all claim limitations and no other references are being applied in the Section 103 rejection. In particular, Underwood does not disclose or suggest to insert a fiber optic into the nucleus. Additionally, the Office Action does not address this shortcoming in the Section 103 rejection. The Office Action does not state where it is suggested to modify the Underwood apparatus to dispose a fiber optic within the nucleus of a disc.

Based on the foregoing, reconsideration and withdrawal of the Section 103 rejection is respectfully requested.

CLOSING COMMENTS

Applicant has made a sincere effort to respond to each of the rejections raised in the Office Action. If the Examiner believes a telephone conference would expedite prosecution of this application, a telephone call to the undersigned attorney at below listed number will be appreciated.

Respectfully submitted,



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Date

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